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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/787,130

02/27/2004

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Q80148

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04/16/2009

SUGHRUE-265550

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EXAMINER

XAVIER, VALENTINA

ART UNIT

PAPER NUMBER

3644

MAIL DATE

DELIVERY MODE

04/16/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/787,130	<b>Applicant(s)</b> EZUKA, NAOYUKI	
	<b>Examiner</b> VALENTINA XAVIER	<b>Art Unit</b> 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,7-13 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-13 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/21/2009 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 – 4, 9, 12, 15 and 17 are rejected under 35 U.S.C. 103(a) as being obvious over Yamamoto (US 5,048,223) in view of Wallace (US 3,778,916) and Werner (US 6,620,286).**

Yamamoto et al. '223 discloses a fishing rod comprising a rod pipe 11 that is inserted into a reinforced tubular body 12 (**See Fig. at the end of this Office Action**), and a body

(material between 12a and 12e – See Fig. at the end of this Office Action) connected with an outer side of the tubular body 12, See Fig. 2. Yamamoto et al '223 fails to disclose the body (material between 12a and 12e – See Fig. at the end of this Office Action) being a synthetic resin body, however, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the body taught by Yamamoto et al '223 using synthetic resin in order to provided durability and strength.

Yamamoto et al '223 fails to disclose the tubular body and the synthetic resin body being integrally molded. However, Applicant's product-by-process claims of integrally molding these two portions together are not limited to the manipulations of the recited steps, only the end structure implied by the steps. Yamamoto '223 therefore recites a “one piece” construction of the tubular body and the tubular synthetic body.

While Yamamoto discloses the tubular body and the tubular synthetic body being in one piece, it does not disclose that tubular body and the synthetic body are made of two different materials. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use two different materials for the tubular body and the synthetic body, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

An adhesive agent (bonding agent, Yamamoto '223, col.4, ll.30-33) is formed in recess 12e works as an adhesive for fixing the grip (13) – this grip is made of a material softer (cork or foam) than that of the bodies it surrounds.

Regarding claim 4, opening 12a is ready to receive a leg of a reel.

Regarding the transparent characteristic of the synthetic resin body, Yamamoto '223 does not positively disclose whether the construction materials used are colored, opaque, transparent, translucent, etc. Wallace discloses a fishing rod having a handle that he teaches may be made of colored or transparent material for decorative purposes (Wallace, col.1, lns.59-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a transparent or translucent material for decorative purposes.

Yamamoto '223 fails to disclose the "concealing film". However, Werner discloses a double-sided tape having a "concealing film" (28). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the adhesive agent of Yamamoto '223 to include the element 28 as taught by Werner in order to provide a carrier for the adhesive to ensure a stronger bond.

**Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being obvious over Yamamoto (US 5,048,223) in view of Wallace (US 3,778,916) and Werner '286 and further in view of Yamamoto et al (US 6,105,302).**

Regarding claim 2, Yamamoto '223, as modified, discloses the claimed invention except it is not positively disclosed that the tubular body is formed of a fiber reinforced prepreg material. Yamamoto '302 teaches the use of such a material, as it is an extremely strong material and will hold up against the forces encountered while sport fishing. It would have been obvious to one having ordinary skill in the art at the time the invention was made

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to use a reinforced prepreg material in order to provide a strong and dependable material, since it has been held that there is no invention in the mere selection of a material that is known in the art for its suitability for the intended purpose. *In re Leshin*, 125 USPQ 416.

Regarding claim 3, portion 12d of synthetic body 12 is considered to be a cover portion.

**Claims 7, 8, 10, 11, 13, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (US 6,105,302).**

Yamamoto et al. '302 (Yamamoto '302) discloses a fishing rod, as best viewed in Figures 1, 2, and 11, comprising a rod pipe 1, a reinforced tubular body 2 made of a reinforced synthetic resin (col.3, lns.45-50), and a synthetic resin body 42, 43 which is bonded to an outside of the tubular member 2. The synthetic resin body is disclosed as optionally being made of a synthetic resin (col.4, ln.37), or a foamed resin material (col.3, lns.63-64), both of which are softer than the reinforced pre-impregnated resin of the tubular member 2.

Yamamoto et al '302 fails to disclose that the tubular body and the tubular synthetic body are not made of two different materials. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use two different materials for the tubular body and the synthetic body, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claim 8, the tubular body is inside member 42 of the resin body and is projected or extends in an axial direction of the tubular body.

Regarding claim 10, the tubular body 2 is made from a fiber reinforced plastic.

Regarding claim 11, member 41 is optionally made from a foamed material, artificial cork, or natural cork (col.3, lns.63-64).

Regarding claim 13, a reel mount is meant to fit inside portion 43 of the resin body (Figure 6).

Yamamoto et al '302 fails to disclose the tubular body and the synthetic resin body being integrally molded. However, Applicant's product-by-process claims of integrally molding these two portions together are not limited to the manipulations of the recited steps, only the structure implied by the steps. Yamamoto '223 therefore recites a "one piece" construction of the tubular body and the tubular synthetic body.

### ***Response to Arguments***

Applicant argues that Yamamoto '223 does not disclose the tubular body and the tubular synthetic body being integrally molded together. However, Applicant's product-by-process claims of integrally molding these two portions together are not limited to the manipulations of the recited steps, only the structure implied by the steps. Yamamoto '223 therefore teaches a single piece construction of the tubular body and the tubular synthetic body.

Applicant also argues that the tubular body and the tubular synthetic body are not made of two different materials. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use two different materials for the tubular body and the synthetic body, since it has been held to be within general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Furthermore, Applicant argues the Werner reference, stating that the carrier 28 is not an opaque concealing film. However, Col. 4; lines 52 – 65 of Werner clearly states that the carrier may be made of paper, which would be an opaque material.

With respect to arguments regarding Yamamoto '302, Applicant states that the tubular body and the tubular synthetic body are not integrally molded together. However, Yamamoto has already been modified stating that it would be obvious to one of ordinary skill in the art to use two different materials for these two bodies. Applicant's product-by-process claims of integrally molding these two portions together are not limited to the manipulations of the recited steps, only the structure implied by the steps. Yamamoto '223 therefore recites a “one piece” construction of the tubular body and the tubular synthetic body.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALENTINA XAVIER whose telephone number is (571)272-9853. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on (571)272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael R Mansen/  
Supervisory Patent Examiner, Art Unit 3644

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